

REMARKS

Applicant is in receipt of the Office Action mailed January 13, 2004. Claim 1 has been amended to correct omission of a semi-colon, and a conjunctive. Applicant respectfully submits that the claims as currently presented are allowable, and that the case is in condition for allowance. Further consideration of the present case is earnestly requested in light of the following remarks.

In the Office Action, the Examiner asserts that Risberg teaches a graphical program, in that the program presented by Risberg includes graphics, such as various graphical user interface elements. Applicant submits that this interpretation of “graphical program” is not the generally accepted meaning of the term in the art of programming. This point is specifically made in the background of the present application, where “graphical programming” is contrasted with “text-based programming”. Applicant thus respectfully submits that Risberg does not teach a graphical program.

The Office Action admits that Risberg does not teach a graphical program where the “graphical program includes a block diagram comprising a plurality of connected nodes, wherein the connected nodes visually represent functionality of the graphical program”, but asserts that it would have been obvious to combine Risberg with Kodosky, and that such a combination produces Applicant’s invention as claimed. More specifically, the Office Action rejected claims 1, 4-11, 14-15, 24, and 27-34 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,339,392 to Risberg et al (“Risberg”) in combination with U.S. Patent No. 5,291,587 to Kodosky (“Kodosky”). Applicant respectfully disagrees.

Amended claim 1 recites:

1. A method for configuring a graphical program to publish or subscribe to a data target or data source, respectively, the method comprising:
receiving user input specifying at least one of a data source or data target;

automatically configuring the graphical program to perform at least one of: 1) receiving data from the specified data source; and/or 2) publishing data to the specified data target;

wherein the graphical program includes a block diagram comprising a plurality of connected nodes, wherein the connected nodes visually represent functionality of the graphical program, wherein said automatically configuring comprises automatically configuring the block diagram; and

wherein said automatically configuring is performed based on the user input specifying at least one of a data source or data target.

As the Examiner is certainly aware, to establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In *re* Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In *re* Bond, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

Furthermore, as held by the U.S. Court of Appeals for the Federal Circuit in *Ecolochem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Applicant submits that neither Risberg nor Kodosky provides a motivation to combine. Further, Applicant submits that the combination of Risberg and Kodosky does not teach the present claims. Applicant submits that Risberg’s system is directed to

creation of custom active documents (Abstract), whereas Applicant's system relates to automatic configuration of a graphical program [defined in the Application], as represented in claim 1. Although both systems include specifying data sources, Applicant notes that Risberg's system of custom active documents does not provide general purpose programming functionality, and so Applicant submits that Risberg is non-analogous art with respect to the present application.

The Office Action further asserts that in the combination of Risberg and Kodosky, "an active document would comprise a block diagram, the block diagram including a plurality of connected nodes, wherein the connected nodes visually represent functionality of the active document."

As stated in *C.R. Bard, Inc. v. M3 Sys., Inc.*, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998), "The invention that was made, however, does not make itself obvious; that suggestion or teaching must come from the prior art. See, e.g., *Uniroyal, Inc. v. Rudkin Wiley Corp.*, 837 F.2d 1044, 1051 52, 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor); *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination)."

Applicant notes that nowhere does Risberg teach or suggest, mention, or even hint at, a block diagram as taught by Kodosky; nor does Kodosky teach or suggest, mention, or even hint at, an active document. Thus, Applicant submits that neither of the cited references provides a motivation to combine. Rather, Applicant respectfully submits that the Examiner has simply combined elements from Risberg and Kodosky, using Applicant's claimed invention as a template, to produce the described system. Applicant further notes that combining Risberg and Kodosky would result in a system that includes

both a graphical program *and* an active document. However, Applicant's invention as claimed does not require an active document, and so teaches away from Risberg.

Additionally, nowhere does Risberg mention or even hint at specifying a data source for use in a general purpose graphical program, or even a text-based program, but rather, only describes specifying a data source for an active document, i.e., a page based GUI.

More importantly, while the system of Risberg is particularly directed to displaying data in a "custom graphical user interface" (Examiner's terminology) of an active document, Applicant's invention as represented in claim 1 makes no reference to a GUI. Thus, in the embodiments of the invention represented by claim 1, the data are received by the graphical program from the data source, and may then be used by the graphical program for any purpose. Similarly, in embodiments where a data target is specified, the program may publish data to the specified target, which may also use the data in any way desired. Thus, in both embodiments, the data received or published may or may not be displayed in a GUI. Thus, for at least these reasons, Applicant submits that the combination of Risberg and Kodosky is improper, and that even if the references are combined, the resulting combination is not capable of the functionality described in claim 1, and thus does not teach Applicant's invention as claimed.

Furthermore, Applicant notes that neither Risberg nor Kodosky teaches or describes "automatically configuring the graphical program to perform at least one of: 1) receiving data from the specified data source; and/or 2) publishing data to the specified data target", as recited in claim 1. Rather, in the cited column 11, line 35 – column 12, line 28, Risberg describes a system in which a user manually creates or inserts a display object, i.e., an active object, in an active document comprising one or more sheets, and specifies a data source for the display object, after which the display object displays data from the specified data source. In other words, the user configures the document, or more specifically, the display object included in the document, to receive data from the specified source. Applicant notes that in Risberg's system, no graphical program is automatically (i.e., programmatically) configured to subscribe to a data source or publish

to a data target in response to the user input specifying the source or target. Similarly, while Kodosky describes graphical programs, comprising block diagrams and front panels, nowhere does Kodosky teach or suggest the feature of “automatically configuring the graphical program to perform at least one of: 1) receiving data from the specified data source; and/or 2) publishing data to the specified data target”. Thus, even if the Risberg and Kodosky references were combinable, which Applicant argues they are not, the combination would not teach or suggest at least this element of the present claims. Specifically, neither Risberg or Kodosky, either singly or in combination, teach this element of the present claims.

Thus, for at least the reasons provided above, Applicant respectfully submits that neither Risberg nor Kodosky, either singly or in combination, teaches or suggests the features and limitations of claim 1, and so claim 1, and claims dependent thereon, are patentably distinguishable over the cited art, and are thus allowable.

Independent claims 24 and 31 contain similar limitations as claim 1, and so the arguments provided above apply with equal force. Thus, Applicant respectfully submits that claim 1, and claims dependent thereon, are patentably distinguishable over the cited art, and are thus allowable.

Removal of the 103 rejection of claims 1, 4-11, 14, 15, 24, and 27-34 is respectfully requested.

The Office Action rejected claims 16, and 19-23 under 35 U.S.C. 103(a) as being unpatentable over the combination of Risberg and Kodosky, and also over Microsoft Office 97, as described in the book Mastering Microsoft Office 97, Professional Edition (“Office 97”). Applicant respectfully disagrees.

Claim 16 recites:

16. A method for configuring a graphical user interface (GUI) element to display data during execution of a graphical program, the method comprising:

receiving user input specifying a data source, wherein the user input is received to a block diagram of the graphical program, wherein the block diagram comprises a

plurality of connected nodes, wherein the connected nodes visually represent functionality of the graphical program;

automatically displaying a GUI element in a graphical user interface of the graphical program; and

automatically configuring the GUI element to receive and indicate data from the specified data source during execution of the graphical program;

wherein said automatically displaying and said automatically configuring are performed based on the user input specifying the data source.

Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor. See *ATD Corporation v. Lydall, Inc.*, 48 USPQ 2d 1321, 1329 (Fed. Cir. 1998)

As also indicated by *In re Rouffet*, 47 USPQ 2d 1453, 1456 (Fed. Cir. 1998), "when determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" See *In re Beattie*, 974 F.2d 1309, 1311 12, 24 USPQ 2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

And as also indicated by *In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998), "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579 80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by

finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

Similar to above, Applicant submits that combining Risberg, Kodosky, and Office 97 is improper, for at least the reason that Applicant's invention as claimed is directed to graphical programming, as is Kodosky, whereas Risberg and Office 97 are both directed to active documents, i.e., to systems where GUIs are embedded in page- or sheet-based documents, and which do not teach programming languages, specifically, graphical programming languages. For example, in the Office 97 system, the GUIs are embedded in text-based "word processing" documents. Applicant submits that while aspects of all of these different systems may involve GUIs, no motivation to combine is provided in the cited references, and the scope, functionality, and purpose of (general purpose) graphical programming differs so substantially from that of active documents, that combining Risberg, Kodosky, and Office 97 is not only unobvious, but also improper. Applicant further notes that combining Risberg, Kodosky, and Office 97 would result in a system that includes a graphical program (comprising interconnected nodes), and an active document, which would also include a text-based word processing document, and thus would not produce Applicant's invention as claimed.

For at least the reasons provided above, Applicant respectfully submits that claim 16, and claims dependent thereon, are non-obvious and patentably distinct over Risberg, Kodosky, and Office 97, and are thus allowable. Removal of the section 103 rejection of claims 16, and 19-23 is respectfully requested.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION


In light of the foregoing amendments and remarks, Applicant submits the application is now in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-50900/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Notice of Change of Address

Respectfully submitted,



Jeffrey C. Hood
Reg. No. 35,198
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert & Goetzel PC
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8800

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